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09/291,245	04/13/1999	CARY LEE BATES	R0998-223	1843

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EXAMINER

EBRAHIMI DEHKORDY, SAEID

ART UNIT PAPER NUMBER

2622

DATE MAILED: 02/11/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/291,245

Applicant(s)

BATES ET AL.

Examiner

Saeid Ebrahimi-dehKordy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **FINAL ACTION**

### **Response to Arguments**

Applicant's amendment filed on December 04 2002 has been entered and made of record.

Applicant's arguments have been fully considered but are not persuasive for the 103 comments

Applicant argues that Brobst et al U.S. patent 6,061,700 and Kelly et al U.S. patent 6,320,671 and the present invention are commonly known at the time the present invention was made. Brobst et al U.S. patent 6,061,700 and Kelly et al U.S. patent 6,320,671 are disqualified as prior art pursuant to 35 USC 103 (C) and can not be applied as a reference to the subject patent application under 35 USC 103.

Examiner disagrees and indicates that the effective date for the change to include 102(e) in the prior art exclusion in 103 © is 11/29/99,

Examiner also include therein the copy of the Examiner prior art exclusions under 35 U.S.C. 103 © paper number 100.

Applicant argues that the print index is explicitly specified by a web based document originator.

Examiner disagrees and as indicated by the applicant after contacting Ms, Joan

Pennington on January 29 and 2:00 P.M. to clarify the amended part of the claims 1,22

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and 25 and was explained that the originator is the USER, Examiner note that Brobst et al (U.S. patent 6,061,700) On Fig.3 column 5 lines 20-32 where Brobst et al teach the selection of URL's by the user.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-13, 16 and 19-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Brobst et al. (U.S. Patent 6,061,700).

Regarding claim 1 Brobst et al disclose: A method for implementing web based document printing comprising the steps of obtaining a print index (please note Fig.5 item 540 which acts as print index, column 6, lines 43-44 where Brobst et al teach the

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selection of related web pages is the device 540 (Web page selection mechanism) which acts as print index). and identifying uniform resource locators (URLs) in said print index (please note Fig.5 column 6, lines 44-48, where Brobst et al teach the collection of URLs to be formatted or indexed to the on page to be printed). and sequentially printing said URLs in said print index (please note column 5, lines 11-20 where the list of URLs and Web pages being assembled and being placed in Sequential order, also please note column 6, lines 29-35 where Brobst et al teach the printing of the web pages and URLs).

Regarding claim 2 Brobst et al disclose: The method for implementing web based document printing as recited in claim 1 further includes the step of checking for a user selection of confirm print index option (please note column 5, lines 23-25 where user selects and picks the correct URLs or Web pages). and responsive to identifying said user selection of confirm print index option (please note column 5, lines 22-26) performing a display and edit print index routine.

Regarding claim 3 Brobst et al disclose: The method for implementing web based document printing as recited in claim 1 wherein the step of obtaining said print index includes the steps of checking for a user selection of whole print option (please note column 3, lines 31-40) and responsive to identifying said user selection of whole print option checking for a root tag present in the current page (please note column 4, lines 7-11).

Regarding claim 4 Brobst et al disclose: The method for implementing web based document printing as recited in claim 3 includes the steps of responsive to

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identifying said root tag present in the current page, switching to said root tag for printing (please note column 8, lines 1-6).

Regarding claim 5 Brobst et al disclose: The method for implementing web based document printing as recited in claim 1 wherein the step of obtaining said print index includes the steps of obtaining a kind of multi print to perform (please note column 6, lines 44-48).

Regarding claim 6 Brobst et al disclose: The method for implementing web based document printing as recited in claim 5 includes the steps of checking for a user selection of honor HTML responsive to identifying said user selection of honor HTML, checking for a print index in the current page (please note column 3, lines 13-22).

Regarding claim 7 Brobst et al disclose: The method for implementing web based document printing as recited in claim 6 includes the steps of responsive to said print index in the current page returning said print index (please note column 6, lines 1-4).

Regarding claim 8 Brobst et al disclose: The method for implementing web based document printing as recited in claim 6 includes the steps of checking for a user selection of print equal yes and anchor tags present in the current page (please note column 8, lines 32-60). and responsive to Identifying said user selection of print equal yes and anchor tags present in The current page returning scattered print (please note column 9, lines 1-32).

Regarding claim 9 Brobst et al disclose: The method for implementing web based document printing as recited in claim 8 includes the steps of responsive to not

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identifying said user selection of print equal yes and anchor tags present in the current page returning only current page print (please note column 8, lines 43-60).

Regarding claim 10 Brobst et al disclose: The method for implementing web based document printing as recited in claim 6 includes the steps of responsive to not identifying said user selection of honor HTML, checking for a user selection of print index (please note column 9, lines 22-55).

Regarding claim 11 Brobst et al disclose: The method for implementing web based document printing as recited in claim 10 includes the steps of responsive to identifying said user selection of print index, checking for a print index present in the current page (please note column 6, lines 44-50)

Regarding claim 12 Borbst et al disclose: The method for implementing web based document printing as recited in claim 11 includes the steps of responsive to identifying said print index present in the current page returning said print index (please note column 6, lines 1-4).

Regarding claim 13 Brobst et al disclose: The method for implementing web based document printing as recited in claim 12 includes the steps of responsive to identifying said print index present in the current page returning only current page print (please note column 6, lines 46-50).

Regarding claim 16 Borbst et al disclose: The method for implementing web based document printing as recited in claim 5 includes the steps of checking for an existing print index and responsive to identifying said existing print index returning said existing print index (please note column 5, lines 22-30).

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Regarding claim 19 Borbst et al disclose: The method for implementing web based document printing as recited in claim 5 includes the steps of creating a print index containing only the current page (please note column 6, lines 46-52).

Regarding claim 20 Borbst et al disclose: The method for implementing web based document printing as recited in claim 1 includes the steps of identifying a user selection of level first and creating a print index to print highest level orders first (please note column 5, lines 11-19)

Regarding claim 21 Borbst et al disclose: The method for implementing web based document printing as recited in claim 1 includes the steps of identifying a user selection of branch first and creating a print index to sequentially print each branch Please note Fig.4 column 5, lines 16-19 and column 6, lines 46-50).

Regarding claim 22 Borbst et al disclose: Apparatus for implementing web based document printing comprising: stored document print index (please note Fig.5 item 540 which acts as print index, column 6, lines 43-44 where Brobst et al teach the selection of related web pages is the device 540 (Web page selection mechanism) which acts as print index). said document print index including a list of user selected uniform resource locators (URLs) to be printed (please note Fig.5 column 6, lines 44-48, where Brobst et al teach the collection of URLs to be formatted or indexed to the on page to be printed). and a web based printing program utilizing said stored document print Index for printing a document including said list of user selected uniform Resource locators (URLs) (please note column 5, lines 11-20 where the list of URLs and Web



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pages being assembled and being placed in Sequential order, also please note column 6, lines 29-35 where Brobst et al teach the printing of the web pages and URLs).

Regarding claim 23 Borbst et al disclose: Apparatus for implementing web based document printing as recited in claim 22 includes a scattered print specification, said scattered print specification including a URL print control function with HTML elements (please note Fig.9 where Brobst et al teach the use of "Anchor Tag" to select the desire page to be printed, column 8, lines 32-67 and column 9, lines 1-35).

Regarding claim 24 Borbst et al disclose: Apparatus for implementing web based document printing as recited in claim 23 includes a print order number and a print order control (please note column 9, lines 33-35).

Regarding claim 25 Brobst et al disclose: a computer program product implementing web based document printing comprising: a recording medium (please note column 6, lines 51-53). Means, recorded on the recording medium for storing a print index (please note Fig.5 item 540 which acts as print index, column 6, lines 43-44 where Brobst et al teach the selection of related web pages is the device 540 (Web page selection mechanism) which acts as print index). Said print index including a list of user selected uniform resource locators (URLs) to be printed (please note Fig.5 column 6, lines 44-48, where Brobst et al teach the collection of URLs to be formatted or indexed to the on page to be printed). means, recorded on the recording medium, for obtaining said print index and for printing a document including said list of user selected uniform resource locators (URLs) (please note column 6, lines 43-53 where Brobst et al teach the collection of URLs and the way the get printed).

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Regarding claim 26 Brobst et al disclose: The computer program product implementing web based document printing as recited in claim 25 includes means recorded on the Recording medium for identifying a user selected scattered print specification And means, recorded on the recording medium, for identifying URLs with HTML elements having anchor tags of a user selection of print equals yes And for printing a document including said URLs with HTML elements having Anchor tags of said user selection of print equals yes (please note Fig.9 where Brobst et al teach the use of "Anchor Tag" to select the desire page to be printed, column 8, lines 32-67 and column 9, lines 1-35).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 14-15 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brobst et al. (U.S. patent 6,061,700) in view of Kelley et al (U.S. patent 6,320,671).

Regarding claim 14 Brobst et al dose not disclose: The method for implementing web based document printing as recited in claim 10 includes the steps of responsive to not identifying said user selection of print index, checking for a user selection of scattered

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print And responsive to identifying said user selection of scattered print, returning Scattered print.

On the other hand Kelly et al disclose:

Implementing web based document printing as recited in claim 10 includes the steps of responsive to not identifying said user selection of print index checking for a user selection of scattered print And responsive to identifying said user selection of scattered print (please note column 5, lines 10-25 where Kelly et al teach the randomly chosen web pages to be printed by the printer). Returning scattered print (please note column 6, lines 2-7).

Therefore it would have been obvious to a person of ordinary skill in art at the time of the invention to modify Brobst et al's invention according to the teaching of Kelley et al , Kelley et al teach in the same field of endowers the printing of the web pages ands URLs in the scattered format and manual format.

Regarding claim 15 Kelley et al disclose: The method for implementing web based document printing as recited in claim 10 includes the steps of responsive to not identifying said user selection of print index checking for a user selection of manual print (please note column 5, lines 32-34).

And responsive to identifying said user selection of manual print returning Manual print (please note column 5, lines 32-34).

Regarding claim 17 Kelley et al disclose: The method for implementing web based document printing as recited in claim 5 includes the steps of checking for a scattered print option and responsive to identifying said scattered print option, creating a

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print index from scattered anchor tags marked print equal to yes (please note column 5, lines 16-25).

Regarding claim 18 Kelley et al disclose: The method for implementing web based document printing as recited in claim 5 includes the steps of checking for a manual print option and responsive to identifying said manual print option manually creating a print index (please note column 5, lines 32-34).

### **Conclusion**

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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**Contact Information**

- Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Saeid Ebrahimi-Dehkordy* whose telephone number is (703) 306-3487.

The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 5:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L Coles, can be reached at (703) 305-4712.

**Any response to this action should be mailed to:**

Assistant Commissioner for Patents  
Washington, D.C. 20231

**Or faxed to:**

(703) 872-9314, or (703) 308-9052 (for **formal** communications; please mark  
"EXPEDITED PROCEDURE")


**Or:**

(703) 306-5406 (for **informal** or **draft** communications, please label  
"PROPOSED" or "DRAFT")

**Hand delivered responses** should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist whose telephone number is (703) 305-4750.

*Saeid Ebrahimi-Dehkordy*  
Patent Examiner  
Group Art Unit 2622  
January 29 2003

  
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